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In the Drawings

There are no amendments to the drawings.

Remarks

Applicant makes no amendments and submits the following remarks.

The Examiner has stated that "applicant argues against Nieboer, stating that the reference discloses automatic execution, implying that it is [sic] does not disclose and is incompatible with submission of indications (bids or offers) by player/traders. Applicant fails to note that Nieboer is a modification of traditional trading systems . . . which clearly discloses submission of indications (bids or offers) by player/traders." (Official Action 6/7/06, p. 9.) Contrary to the Examiners mischaracterization of Applicants submission, Applicant has never implied that U.S. Patent No. 6,418,419 ("Nieboer et al.") does not disclose non-automatic systems. In fact, Nieboer et al. goes to great lengths explaining why such systems are deficient and inefficient. (See, Abstract, Col. 4, lines 15-21; Col. 7, lines 63-67 & Col. 15, lines 63-64.) Applicant does agree with the Examiner's comments that Nieboer et al. is incompatible with manual submission of indications. As previously submitted, Nieboer et al. has specifically rejected manual selection, in fact, the entire premise of the patent is an "Automated System For Conditional order Transactions In Securities Or Other Items In Commerce." (Title of the Invention) (emphasis added).

The test for obviousness for modifying and combining references is not whether a limitation was disclosed in the prior art, but whether the prior art also suggests the desirability of the modification and/or combination. See, e.g., MPEP 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combi-

nation obvious unless the prior art also suggests the desirability of the combination.”); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). In the present case, Applicant respectfully submits that, yes, Nieboer et al. disclosed manual systems, but Nieboer et al. also specifically and categorically rejected a manual systems. The Examiner is ignoring the primary teachings of Nieboer et al., stating that a manual selection is obvious because the background discloses that manual systems have been known.

The Examiner goes on to state that “one of ordinary skill in the art would recognize its disclosure of manual function as well, thus allowing modification by the secondary references. Applicant cites only limited portions of the primary reference to present arguments, but the prior art o[f] record must be appreciated in its entirety.” (Official Action 6/7/06, p. 9.) Applicant agrees that a reference must be viewed for what it teaches as a whole. In this case, Nieboer et al. absolutely rejects manual selection of indications. In view of this, Applicant cannot imagine how the argument could be made that based on the teachings of Nieboer et al., manual selection of indications is “obvious.”

Applicant notes that the Examiner has simply ignored Applicants argument that modification of Nieboer et al. as suggested by the Examiner would render the Nieboer et al. unsatisfactory for its intended purpose and therefore absolutely cannot be “obvious.” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

With regard to the Examiner response to Applicants second line of arguments, the Examiner states that “Applicant argues limited portions of Nieboer, stating that the reference indications are anonymous, and that Nieboer does not disclose identification of indications with a player/trader” and that “Nieboer discloses this limitation at Background of the Invention.” (Official Action 6/7/06, p. 9.) Applicant vehemently disagrees with the Examiner’s mischaracterization of Applicants arguments. Applicant has never submitted that Nieboer et al. does not disclose non-anonymous systems. Rather, Applicant has submitted that Nieboer et al. has specifically rejected non-anonymous systems. For example, Nieboer et al. states “[t]he present invention is an anonymous system; the current verbal network is neither efficient nor anonymous.” (Col. 1, lines 39-41 (emphasis added); See, Col. 15, lines 63-63 “The system is anonymous”; See, Abstract “[a]n apparatus and method of automatically and anonymously buying and selling positions in fungible properties between subscribers” (emphasis added); See *also* Col. 3, line 37).

Again, the test for obviousness for modifying and combining references is not whether a limitation was disclosed in the prior art, but whether the prior art also suggests the desirability of the modification and/or combination. See, *e.g.*, MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). In this case a primary teaching of Nieboer et al. is that the system is automated. Applicant is not arguing “limited portions of Nieboer” as suggested by the Examiner, but rather cited explicit teaching in the specification both in the Abstract, objects of the invention and the

detailed specification. On the contrary, all of the disclosure that the Examiner submits Nieboer et al. teaches is taken from the background section, is identified with the prior art and is rejected by Nieboer et al.

The fact that the Examiner goes on to state that “Chitnis likewise discloses identification of player/traders, as its invention is in the form of a board game” does not change the fact that Nieboer et al. teaches away from this limitation and therefore combination of the two references as suggested cannot be obvious. (Official Action 6/7/06, p. 9.)

Finally, the Examiner further states that “the negotiation disclosed by Nieboer clearly suggests that traders be identified; why would one negotiate with a counter-party whom he/she did not know?” (Official Action 6/7/06, pp. 9-10.) Applicant notes that the Examiner has not cited any support for this statement. Alternatively, Applicant submits that Nieboer et al. teaches the following: “[a]n apparatus and method of automatically and anonymously buying and selling positions in fungible properties between subscribers” (Abstract); “[t]he present invention is an anonymous system; the current verbal network is neither efficient nor anonymous.” (Col. 1, lines 39-41); “The system is anonymous.” (Col. 15, lines 63-63); “The system is . . . anonymous.” (Col. 3, line 37) (emphasis added). Therefore, while the Examiner appears to be denying that Nieboer et al. teaches use of an anonymous system, it is clear that Nieboer et al. is directed to “an anonymous system.” (Col. 1, lines 39-41.)

With regard to the Examiner arguments, Applicant submits that when considering a reference, the reference must be considered for its teachings as a whole and it is inappropriate to pick and choose various elements from the references without regard to what the references teach as a whole. *In re Arkley*, 455 F.2d 586, 587-88, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). In the present case, Nieboer et al. teaches an automated and an anonymous system. These are two of the primary features of the invention. The fact that Nieboer et al. identified prior art system in the background of the invention, does not mean that it would be obvious to adopt and modify Nieboer et al. with these features, especially is this so when Nieboer et al. specifically rejected them.

It is well settled that it is impermissible to assemble the prior art using the pending claims as a roadmap to select various features from the prior art where there is no motivation in the references themselves for doing so. See e.g. *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13, (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In this case, there is no suggestion in Nieboer et al. to make the modification suggested by the Examiner and in fact, the prior directly teaches away from the suggested modification. Accordingly, Applicant requests the Examiner to withdraw his rejections.

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It is respectfully submitted that claims 1 – 25, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

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Gene S. Winter, Registration No. 28,352
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155